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10/662,599

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Bruce L. Kennedy

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

09/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/662,599 | Applicant(s) KENNEDY, BRUCE L. | |
| | Examiner PHILIP R. SMITH | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23, 26-31 and 46-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-23, 26-31 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/27/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

BPAI Decision

- [01] The Examiner's decision to reject claims 19-31 and 46-47 under 35 U.S.C. § 103(a) as unpatentable over Beutter and Winkler was reversed. The Board found that "when the touch screen 206 of Winkler is closed (first position) it is located "within a footprint" of housing 202. However, when the touch screen 206 is in an open position (second position) we do not find that it extends from the footprint of the housing 202, as also required by claim 19." BPAI decision at 5. This finding is entirely dependent on a limitation gleaned from the drawings. In particular, the Board states that "[w]e construe the words *extended from said footprint of said housing*, as called for in claim 19, to mean extending out from the *vertically extending boundaries* of the footprint of the housing" (emphasis added, internal quotes omitted). BPAI decision at 5. Therefore Winkler, as currently applied, does not meet the claim limitation "extending out from the *vertically extending boundaries* of the footprint of the housing."
- [02] The Examiner's decision to reject claims 19 and 49 under 35 U.S.C. § 103(a) as unpatentable over Beutter and Rosen was affirmed.

Claim Rejections - 35 USC § 112, First Paragraph

- [03] The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- [04] Claim(s) 24-25 is/are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- [05] Both claims recite that said touch screen is easier to deflect in one direction (opening) than in the other direction (closing). According to the specification, the touch screen is attached by a "hinge 142" that is equipped with "one or more tapping mechanisms". Conventional hinges are equally easy to deflect in either direction. The specified "hinge 142" appears to be a conventional hinge. The only unconventional feature is a "tapping mechanism". It is not entirely clear what a tapping mechanism is, but there is no suggestion that it makes the "hinge 142" more deflectable in one direction than in another.

Withdrawn Rejections

- [06] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [07] The rejection of claims 19-31, 46-47 as being unpatentable over Beutter (2003/0076410) in view of Winkler (6,411,851), as previously applied, failed to address the claim limitations in Figure 15, and is therefore withdrawn, as required by the BPAI decision.
- [08] Winkler does not specifically disclose that the touch screen extends out from the *vertically extending boundaries* of the footprint of the housing. As noted by the Board, "Winkler does not disclose a touch screen that is movable between a first position within a footprint and a second position extended from said footprint [as shown in Figure 15]."
- [09] At the time of the invention, it would have been obvious to a person of ordinary skill in the art to tilt the device ever so slightly such that the touch screen extends out from the vertically extending boundaries of the footprint of the housing. Winkler does not specifically suggest that the device is to

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be tilted, but it is inherently capable of doing so. A skilled artisan would be motivated to tilt the device if, e.g., the most convenient place to set it down was not perfectly flat. Winkler's device is clearly capable of being set down on a tilted surface. In the normal course of use, Winkler's device will be rested on a non-flat surface, and the touch screen of Winkler's device will extend out from the vertically extending boundary of the footprint of the housing.

- [10] The rejection of claim 48 as being unpatentable over Beutter (2003/0076410) in view of Winkler (6,411,851) and in further view of Watai (2003/0060678) is also withdrawn.

Claim Rejections - 35 USC § 103

- [11] Claims 19-23,26-31,46-47,49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter (2003/0076410) in view of Rosen (2002/0149706)

- [12] With regard to claim 19:

[12a] Beutter discloses a medical video instrument having touch screen control comprising:

- a touch screen (“[i]n response to touch-screen or voice generated commands...”) for entering control commands (“the operating room control center 42 generates control signals to the camera control unit 34,” [0030]) to control said medical video instrument (“endoscopic viewing system 20,” [0026]), said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen;
- a processor (“operating room control center 42,” as noted above) for receiving said control commands and for generating control signals to operate said medical video instrument;
- the processor disclosed by Beutter is inherently enclosed by a housing.

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[12b] Beutter does not disclose

- that said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing.

[12c] Rosen discloses

- that a touch screen ("20") is movable between a first position at least partially within a footprint ("slot 18") of a housing and a second position (see Figures 5-6) extended from said footprint ("free space adjacent to free edge 16") of said housing. See [0025]-[0028].

[12d] At the time of the invention, it would have been obvious to a person of ordinary skill in the art that to combine the medical video instrument disclosed by Beutter with the retractable monitor disclosed by Rosen. It is obvious to combine prior art elements according to known methods to yield predictable results. In combination, the medical video instrument and the retractable monitor would have performed the same function as they had separately; a skilled artisan would have recognized that the result of the combination was predictable.

[13] With regard to claim 20: the touch screen is un-pluggable from said housing.

[14] With regard to claim 21: said housing and said touch screen include stackable mating plug portions.

[15] With regard to claim 22: said touch screen can be used by a plurality of medical instruments.

[16] With regard to claim 23: said touch screen is deflectable about an axis ("x" in Figure 6; [0028]) of said housing.

[17] With regard to claim 26: said touch screen presents a keyboard to a user.

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- [18] With regard to claim 27: Beutter further discloses a sensor ("camera head 28," [0027]) in communication with said processor, said sensor receiving control signals to operate said medical instrument.
- [19] With regard to claim 28: Beutter discloses a speech recognition module ("voice-generated commands," [0030]) executing on said processor, said speech recognition module receiving voice signals that control said medical instrument.
- [20] With regard to claim 29: Beutter further discloses an expert system executing on said processor, said expert system generating control signals to operate said medical instrument ("operating room control center 42 generates control signals" as noted above).
- [21] With regard to claim 30: said touch screen slides out of said housing.
- [22] With regard to claim 31: said touch screen slides out of said housing and is deflectable.
- [23] With regard to claim 46: said medical video instrument generates video data that is displayed on said touch screen.
- [24] With regard to claim 47: comprising a video screen coupled to said processor ("captured image that is presented on monitor 36" [0030] of Beutter), and wherein said medical video instrument generates video data that is displayed on said video screen.
- [25] With regard to claim 49: As noted above, Rosen discloses that said touch screen is in the first position, said touch screen is positioned within an interior cavity of said housing and when said touch screen is moved to the second position, the touch screen [is] positioned at least partially outside of said cavity.

Additional Claim Rejections - 35 USC § 103

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[26] Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beutter (2003/0076410) in view of Rosen (2002/0149706) and in further view of Watai (2003/0060678).

[27] Beutter in view of Rosen does not disclose a storage for storing the image stream.

[28] Watai discloses a "hard disk 21e for storing image data" ([0064]).

[29] At the time of the invention, it would have been obvious to a person of ordinary skill in the art to store the image data disclosed by Beutter in view of Rosen as taught by Watai. A skilled artisan would be motivated to do so in order to preserve captured medical data.

Conclusion

[30] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.

[31] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.

[32] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/
Examiner, Art Unit 3739